

PTO/SB/33 (07-05)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

020375-050000US

"Express Mail" Label No. EV720989605US
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By: Thia L. McNeill

Application Number

10/825,971

Filed

April 16, 2004

First Named Inventor

Steven L. VanFleet

Art Unit

3621

Examiner

Evans J. Augustin

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 44,037☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34. _____

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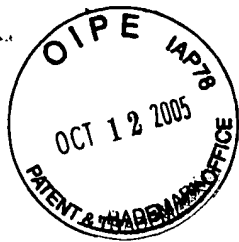
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Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒*Total of one forms are submitted.



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PATENT
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By: Theresa L. McNeill

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Steven L. VanFleet et al.

Application No.: 10/825,971

Filed: April 16, 2004

For: METHODS AND SYSTEMS FOR
ONLINE TRANSACTION
PROCESSING

Confirmation No.: 8224

Examiner: Evens J. Augustin

Art Unit: 3621

PRE-APPEAL BRIEF REQUEST FOR
REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants request review of the final rejection mailed by the Office for the above-identified application on May 24, 2005 ("the Final Office Action"). An Advisory Action was mailed on September 14, 2005 indicating that a Response filed on July 25, 2005 under 37 C.F.R. §1.116 ("the Response") did not place the application in condition for allowance. Applicants believe the rejections contain clear factual and legal deficiencies.

A Notice of Appeal is being filed concurrently herewith.

1. Status of Claims

Claims 1 – 7, 9, 14 – 23 and 25 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,609,113 (“O’Leary”); and Claims 8, 10 – 13 and 24 stand rejected under 35 U.S.C. § 103(a) as unpatentable over O’Leary in view of U.S. Publication No. 2002/005400 (“Chien”).

2. Claims 1 – 9 and 14 – 25

The rejections of Claims 1 – 9 and 14 – 25 rely on a correspondence that has been drawn between O’Leary’s description of a “transaction ID” with the “credential” that is recited in the claim (Final Office Action, p. 2, ll. 10 – 14): the Final Office Action relies on O’Leary as disclosing “determining from the credential, ... account information that identifies a financial account maintained by the customer at a financial institution and authorization information that allows debit access to the identified financial account” (Final Office Action, p. 2, ll. 10 – 14). Such reliance is factually erroneous.

In O’Leary, such a determination is not made “from the credential” as the claims require. This is true even without addressing whether the proposed correspondence of the recited “credential” with O’Leary’s “transaction ID” derives from a proper construction of the claim term and whether it properly encompasses the “transaction ID” described in O’Leary.

Specifically, O’Leary includes no disclosure of a determination of “account information that identifies a financial account maintained by the customer at a financial institution and authorization that allows debit access to the identified financial account” being made from the transaction ID. Instead, O’Leary teaches that the “transaction ID” be provided to the buyer and that the buyer include the transaction ID in the EFT credit message sent to the Internet Merchant’s VPL account (O’Leary, Col. 14, ll. 61 – 63). The stated purpose of the “transaction ID” is to allow “the recipient of the

credit . . . to match the received credit with a proposed purchase” (*id.*, column 14, lines 47–58). Rather than determine account information from the “transaction ID,” access to the buyer’s account is instead made through the Payment Portal Processor (“PPP”) enhanced Wallet functionality, such as described at Col. 16, ll. 18 – 35 of O’Leary.

This argument is made more fully in the Response at p. 9 – 10.

3. Claims 10 – 13


The rejections of Claims 10 – 13 rely on *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) for the proposition that “making integral what had been made previously [is] not patentable” (Final Office Action, p. 3, ll. 10 – 11). Such reliance is legally erroneous.

The proposition on which the Final Office Action relies is not a holding of *Larson*. The relevant portion of *Larson* was concerned with a claim limitation that recited “a brake drum integral with a said clamping means.” *Larson*, 340 F.2d at 968, 144 USPQ at 349. An argument had been proffered that because a brake disk was “rigidly secured” to a clamping means instead of being fabricated from a single piece, the claim limitation requiring that it be “integral” with the clamping means was not met. This is the argument that was rejected by the Board of Appeals of the Patent Office (“the Board”), with the CCPA affirming. The Board stated that “the term ‘integral’ is not limited to a fabrication of the parts from a single piece of metal, but is inclusive of other means for maintaining the parts fixed together as a single unit.” *Larson*, 340 F.2d at 968, 144 USPQ at 349. This was clearly a matter of construing the term “integral” in a particular context (“We are inclined to agree with the board’s construction of the term ‘integral’ as used in claim 12.” *Larson*, 340 F.2d at 968, 144 USPQ at 349). Construction of the term “integral” is irrelevant to independent Claim 10 since the word does not appear in the claim. Contrary to the assertion in the Final Office Action, there

was no general holding in *Larson* that “making integral what had been made previously [is] not patentable.”

This argument is described fully at p. 11 of the Response. The relevance of the argument may be understood further by noting the basis for the Final Office Action’s reliance on the proposed legal statement. It is relied upon in response to Applicants’ observation that O’Leary fails to disclose the limitations of Claim 10 requiring receipt by the payment network of “a first information packet” that comprises both “an electronic file having encrypted content,” which when decrypted “identifies a financial account maintained by the customer,” and “transaction information.” *See* Response filed March 17, 2005, p. 10 and Final Office Action, p. 3.

Respectfully submitted,


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